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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 10/804,425 | 03/18/2004 | Donald R. Titterington | D/A03061HD1 | 7240 |
| 21567 | 7590 | 06/23/2005 | EXAMINER | |
| WELLS ST. JOHN P.S. 601 W. FIRST AVENUE, SUITE 1300 SPOKANE, WA 99201 | | | SERGENT, RABON A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1711 | |
| DATE MAILED: 06/23/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/804,425

Applicant(s)

TITTERINGTON ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 33-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/18/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. It is requested that applicants amend the continuing data within the specification to reflect the current status of application 09/654,735.

2. Claims 33-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, it is unclear what is meant by the language, "selected to include". The language does not constitute proper Markush terminology, and it is unclear to what extent the R groups must contain the recited species.

Secondly, it is unclear what quantity is denoted by "some". It is unclear if the language requires a quantity greater than one.

3. It is noted that the language of claim 33 requires that an additional ring structure be present.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 33-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the following claims of the following copending applications:

| <u>Application</u> | <u>Claim</u> |
|--------------------|--------------|
| 10/369,981 | 16 and 17 |
| 10/422,895 | 39 |
| 10/691,255 | 60 |
| 10/804,495 | All |
| 10/881,047 | All |
| 10/898,432 | 59 and 60 |
| 10/898,724 | 19 and 20 |
| 10/902,602 | 96 and 97 |
| 10/918,619 | 13 and 14 |

Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of copending claims renders compositions containing urethanes derived from abietyl alcohol and either cyclohexyl isocyanate or isophorone diisocyanate

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obvious. In cases where abietyl alcohol is not specifically claimed, this species is rendered obvious by the claiming of fused ring alcohols.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 33-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the following claims of the following U.S. Patents:

| <u>U.S. Patent</u> | <u>Claim</u> |
|--------------------|--------------|
| 6860931 | 19 |
| 6835238 | 19 |
| 6811596 | 10 and 11 |
| 6755902 | 18 and 19 |
| 6726755 | 18 and 19 |
| 6878198 | 26 |
| 6858070 | 23 and 26 |
| 6790267 | 12 and 13 |
| 6764541 | 12 |
| 6761758 | 19 |
| 6673139 | 18 and 19 |
| 6663703 | 18 and 19 |
| 6180692 | All |
| 6057399 | All |
| 6048925 | All |


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| | |
|---------|-----------|
| 6015847 | All |
| 5994453 | All |
| 5919839 | All |
| 5780528 | All |
| 6872243 | 66 and 67 |
| 6821327 | 18 and 19 |
| 6811595 | 19 |
| 5830942 | All |
| 5827918 | All |
| 5783658 | All |
| 5782966 | All |
| 5750604 | All |

Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of copending claims renders compositions containing urethanes derived from abietyl alcohol and either cyclohexyl isocyanate or isophorone diisocyanate obvious. In cases where abietyl alcohol is not specifically claimed, this species is rendered obvious by the claiming of fused ring alcohols.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
June 18, 2005


RABON SERGENT
PRIMARY EXAMINER